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EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/495,622
Filing Date: February 01, 2000
Appellant(s): LEINFELLNER ET AL.

Gerald T. Gray of Townsend and Townsend and Crew LLP
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

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This is in response to the supplemental appeal brief filed 11/13/2006 appealing from the Office action mailed 2/9/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- SnagIt Software (Version 4.3), by TechSmith Corporation, software released 11/14/1998
- US Patent 6,400,378, by Snook, filed 9/26/1997
- US Patent 6,424,996, by Killcommons et al., filed 11/25/1998
- US Patent 6,094,277, by Toyoda et al., filed 11/3/1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 1-4, 7, 9-13, 19 and 21 are rejected under 35 U.S.C. 102(a). This rejection is set forth in a prior Office Action, mailed on 2/9/2004.
- Claims 5, 6, 16, 17 and 20 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 2/9/2004.
- Claims 14 and 15 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 2/9/2004.

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- Claim 18 is rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 2/9/2004.

(10) Response to Argument

Regarding appellant's argument that *"SnagIt fails to teach or suggest the limitation of "sending the composite message from within the game application to the intended recipient over the network" (page 10, first paragraph, of appeal brief filed 11/1/2004) and "It is therefore very clear that SnagIt requires the use of an external mail client for sending messages including screenshots or other multimedia information from the game. It is, therefore, also very clear that SnagIt does not teach or suggest the limitations of sending, or instructions causing a processor to send, "the composite message from within the game application to the intended recipient over the network" as is recited in claims 1 and 19, respectively (emphasis added)" (page 10, last paragraph, of appeal brief filed 11/1/2004) the examiner offers the following additional support for the rejection. SnagIt teaches the use of a personal computer system operating the SnagIt software and the mail function software (in the current example MS Outlook). SnagIt, the mail software and a plurality of other software components are operating concurrently in one environment, i.e. the personal computer. As recited in the claims, nothing requires the invention claimed herein to operate or be contained in a single file or program module. In fact the claimed application/game that the screenshot is derived from will require a plurality of files or program*

modules, including at least an operating system, memory management software, display drivers, and the application/game software. Furthermore the claimed messaging function will require at least network drivers/software, messaging software, display drivers etc. in order to function. SnagIt, operating within the confines of a standard computing environment, anticipates the claimed limitation of *"generating and sending the composite message from within the game application"*.

The appellant further states: *"That is, the hotkey combination of SnagIt neither teaches nor suggests sending a message or of generating a mail form; the hotkey is only directed to capturing an image and making it available as a file that may be processed by, for example, an external e-mail client"* (page 11, second paragraph, of appeal brief filed 11/1/2004) and *"However, nowhere in these Figures or elsewhere in SnagIt is there a teaching or suggestion of sending a message using a hotkey combination"* (page 11, second paragraph, of the appeal brief filed 11/1/2004) the examiner offers the following additional support for the rejection.

SnagIt performs the image, text or video capture function upon activation by the user invoking the hot key combination. SnagIt automatically formats the captured information for system output based upon the SnagIt configuration settings. As shown in Figure 1 of the SnagIt Version 4.3 help system, SnagIt is configured to output the capture information in the form of printer output (shown as *"HP Laser 4200 PCL5e"*). This is the default setting for the SnagIt software.

Other output settings are also possible. SnagIt can be re-configured to automatically output the capture information in the form of an electronic mail message. Figure 3 of the SnagIt Version 4.3 help system discloses the steps to be performed to change the SnagIt output settings so that an electronic mail message (not printer output) is generated upon activation of the hot key combination by the user. These settings are saved in the system environment, so that each time thereafter that the hot key combination is activated, SnagIt generates a mail message for the information capture. A sample mail message generated automatically by SnagIt is shown in Figure 10 of the SnagIt Version 4.3 help system. SnagIt anticipates "*sending a message using a hotkey combination*".

Appellant's arguments related to the rejection of claim 8 (page 12, fourth paragraph to page 13, first paragraph, of the appeal brief filed 11/1/2004) are moot in view of the withdrawn rejection of claim 8 made under 35 USC 102(a). Objections to claim 8 are described above.

The appellant also indicates that rejections under 35 USC 103(a) over SnagIt in view of Snook, Killcommons et al., or Toyoda fail to remedy the deficiencies of SnagIt and also "*fail to teach or suggest the limitations of sending the composite message from within the game application to the intended recipient over the network*" (page 13, each paragraph, of the appeal brief filed 11/1/2004). SnagIt anticipates the claimed limitation of "*sending the composite message from within the game application to the intended recipient over the*

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network" and the supporting references were combined with the primary references for obvious reasons in order to reject limitations recited in dependent claims as described in the office action noted above.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Gregory J. Vaughn
Patent Examiner
Art Unit 2178
March 4, 2005



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